IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Sreekumar K. SESHADRI | Art Unit: 2174

Appl. No.: 10/709,791 | Examiner: KE, PENG

Date Filed: 05/28/2004 | Atty. Docket: ORCL-004/ OID-2003-265-01

For: For Enabling a User to Have a Custom Desired Experience While Accessing an Electronic File

Reply Brief Under 37 CFR § 41.41

Mail Stop **Appeal Brief - Patents**
Commissioner for Patents
P.O. Box 1450
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Sir:

Further to the Appeal Brief Dated 10-June-2009 ("Appeal Brief") and as a response to the Examiner's Answer dated 02-Sep-2009 (hereafter "Examiner's Answer"), Appellants submit this reply brief under 37 CFR § 41.41.

The Commissioner is hereby authorized to be charge any underpayments or credit overpayments to Deposit Account No.: 20-0674 to consider this paper.

Applicants address some of the points made by the Examiner in a section entitled, "(10) Response to Argument" in pages 13-17 of the Examiner's Answer.

It is first noted that, in the Final rejection dated 10-Dec-2008 ("Last Final Office Action"), the Examiner relies on US Patent No. 5,596,702 issued to Stucka *et al* (hereafter "Stucka") for only the following feature of claim 1:

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Stucka teaches a second set of values for controlling a
second electronic file and second entry indicating that
said second experience profile is associated with said
second electronic file, second entry is store and load from
memory (col. 10, lines 1-45). (Page 3 lines 15-17 of the
Last Final Office Action)
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The Examiner now appears to rely on additional portions of Stucka for other features of claim 1, as explained below.

From the below explanation, it may be observed that several disclosures relied upon by the Examiner would contradict at least one claimed feature noted below. From this, it is evident that the Examiner uses impermissible hindsight gleaned only from Applicant's disclosure in selectively choosing different disclosures of Stucka and other references, in asserting that claim 1 is obvious over the art of record.

First, the relevant features required by reasonable construction of independent claim 1, pointed out by the Appellant are first reproduced again for the convenience of the Honorable Board:

(F1) the user be provided the ability to specify different experience profiles in relation to different electronic files in **the same digital processing system**;

(F2) entries indicating the association of different electronic files with corresponding experience profiles **be stored in a memory**;

(F3) requests to **open the two electronic files** be received **after the entries are stored in the memory**;

(F4) the files be opened in response to the open requests and **the experience for the respective files be controlled according to the entries** stored in the memory;

(F5) access **to content** of both the files be provided using the **same application;**

(F6) access to **a substantial portion** of the data stored in each file be provided; and

(F7) the **experience profiles be external** to the electronic files.

With respect to F1 above, the Examiner states as follows:

> A) The combination teaches this limitation because Stucka allows the user to associate different interface files with different application files, (see Stucka figures. 4 and figure 5, col. 10, lines 1-45) In Stucka, **the user may load and associate interface 1 with application A;** (see Stucka fig. 7a, col. 23, lines 60-col. 24, lines 70) and **load and associate interface 2 with application B.** (see Stucka col. 27, lines 55-col. 28, lines 5) Therefore the combination of Craycroft, Novak, and Stucka teaches "the ability to specify different experience profiles in relation to

different electronic files in the same digital processing
system." (Limitation F1 in applicant's argument)
(Page 13, Sixth Full Paragraph of the Examiner's Answer,
Emphasis Added)

Thus, the Examiner relies on features associated with multiple applications, while
feature F5 noted above requires the features be provided by the **same application**.

With respect to F2 above, the Examiner states:

B) The combination teaches this limitation because Stucka
stores application programs and their associated interface
component in its RAM (random access memory), (**see Stucka
fig. 2,** lines 45-62)   Furthermore, **each application is
associated with its own unique interface** (see Stucka, col.
7, lines 54-col. 8, lines 3) Therefore, Craycroft, Novak,
and Stucka teaches "entries indicating the association of
different electronic files with corresponding experience
profiles be stored in a memory." (Limitation F2 in
applicant's argument)
(Page 13, Last Paragraph of the Examiner's Answer, **Emphasis
Added**)

It is respectfully pointed out that Figure 2 of Stucka shows different **applications**
with different associated user interfaces.   Even assuming arguendo that the user
interfaces can be equated to profiles, it is noted that features F5 and F6 require that the
profile be associated with electronic files, **the content of which is accessed**. In Stucka,
the application programs would not have such content, **a substantial part of which is
accessed by users.**

With respect to feature F3 (see page 14 third full paragraph of the Examiner's
Answer), the Examiner relies again on Stucka, which has the same deficiency as noted
above with respect to features F1 and F2.

With respect to feature F4, the Examiner states that:

     D) The combination teaches limitation because Novak
teaches linking respective interface files with associated
application file upon the opening of the application, (see
Novak paragraphs 0021 and 0022) The **application file, media
player, in Novak is associated with a specific interface
file, skin**, where upon execution of the file the interface
component are load into the media player file, (sec Novak
paragraphs 0023, fig. 12) Therefore the combination of

Craycroft, Novak, and Stucka teaches "the files to be
opened in response to the open requests and the experience
for the respective files be controlled according to the
entries stored in the memory." (Limitation F4 in
applicant's argument)
(Starting page 14 last paragraph of the Examiner's Answer,
Emphasis Added)

It is believed that the Examiner equates the claimed experience profile to the skins
of Novak. Such an analogy is incorrect since the skins of Novak are **not** associated with
specific songs (arguably analogous the claimed electronic file) (as required by feature F1
and F2).

With respect to feature F5, the Examiner had stated:

E) The combination teaches this limitation because
Stucka allows the user to associate different interface
files with different application files and these
application files are executable by the same program, (see
Stucka figures. 4 and figure 5, col. 10, lines 1-45) In
Stucka, the user may load and associate interface 1 with
application A; (see Stucka fig. 7a, col. 23, lines 60-col.
24, lines 70) and load and associate interface 2 with
application B. (sec Stucka col. 27, lines 55-col. 28, lines
5) Furthermore, **applicant files A and B are executable by
the same program, the window management system, (see
Stucka, fig. 7, lines 60- col. 8, lines 10)** Therefore the
combination of Craycroft, Novak, and Stucka teaches
"requests to open the two electronic files be received
after the entries are stored in the memory." (Limitation F3
in applicant's argument).
(Page 15, third full paragraph of Examiner's Answer,
Emphasis Added)

Based on the above, it is believed that the Examiner equates the claimed
application with the window management system of Stucka and the claimed electronic
files to the application files A and B of Stucka.

Such an analogy would clearly be unreasonable in view of the specification. The
specification as filed, clearly distinguishes electronic files from user applications
(paragraph 0004 of the specification as filed). It would be unreasonable, and thus
incorrect, to analogize the claimed electronic files to the application files.

The Examiner further relies on KSR Int'l Co. v.Teleflex Inc., 127 S. Ct. 1727, 1734 (2007) in taking the position the references relied upon render obvious the inventions of the subject application.

It is respectfully pointed that KSR permitted combining of the references there when both the references were in a clearly analogous art (related to gas pedal technology). KSR did not intend that the Examiner selectively choose different aspects from different references, when such aspects clearly contradict other recited features of claim (as pointed out above).

As further evidence of unobviousness under the KSR standard, Appellants have provided additional evidence, as explained below.

The Honorable Board's attention is first directed to the fact that the Examiner's answer does not address Section "VII.B.2. Benefits of the present invention do not reasonably follow from the combined teachings of the references" of the Appeal Brief as required by MPEP § 707.07 (f).

Furthermore, the Honorable Board's attention is directed again to section, "VII.B.4. The Environments of the references are fundamentally different" of the Appeal Brief. The Examiner has not addressed this section as well in the Examiner's Answer.

In addressing the question of whether the references relied upon by the Examiner can be combined, the Examiner states that, "And the combination of Craycroft and Stucka is obvious to one of ordinary skilled in the art because **allows multiple applications to be customized as the same time**." (First paragraph of page 17 of the Examiner's Answer, Emphasis **Added**).

It is respectfully noted that claim 1 requires the ability to have different experiences when opening different files **using the same application**. The Examiner's stated motivation is believed to not result in the features recited in claim 1, and thus the

references relied upon by the Examiner would not render obvious the invention of claim 1.

The Honorable Board is accordingly requested to reverse the rejection of claim 1.

With respect to claim 10, it was stated:

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A) Whether the combination of Craycroft, Novak, and Stucka
teaches "a single open action is required to cause the
opening of the file for editing as well as playing the
song."
A) The combination teaches this limitation because Novak
allow user to editing audio format of the song upon users
opening up the file, (see Novak, paragraph 0160-0161) The
users in Novak may manipulate the song being played using
different buttons and scroll bar after the file is opened,
(see Novak, paragraph 0160-0161) Therefore, Novak teaches
"a single open action is required to cause the opening of
the file for editing as well as playing the song."
(Page 17, second and third paragraphs of the Examiner's
Answer, Emphasis Added)
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It is respectfully noted that the manipulation using each button once, amounts to a single action. The Examiner's analogy is against the plain simple meaning of the terms used. The Honorable Board is accordingly requested to reverse the rejection of claim 10.

With respect to claim 29, the Honorable Board's attention is directed to the fact the Examiner relies on different disclosures (Craycroft) in the Examiner's Answer, compared to what was relied upon (Stucka) in the Last Final Office Action.

Unfortunately, such disclosures of Craycroft also have the deficiencies as pointed out in pages 19 and 20 in a section entitled, "VII.E. Rejection of Independent Claim 29" of the Appeal Brief. In particular, the overriding of the default setting by the customized setting in a theme of Craycroft would affect ALL the electronic files opened thereafter with the application. The Honorable Board is accordingly requested to reverse the rejection of claim 29 as well.

Conclusion

The reversal of the Examiner's rejections of claims 1-4, 6-10, 12-22, 27, 29 and 30 is respectfully requested. The Office is invited to telephone the undersigned representative at (443) 552-7281 (4AM-Noon, voicemail otherwise) if it is believed that an interview might be useful for any reason.

Respectfully submitted,
/Narendra Reddy Thappeta/
     Signature

Date: November 2, 2009   Printed Name: Narendra Reddy Thappeta
Attorney for Applicant
Registration Number: 41,416